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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,446	04/23/2001	Sriketan Mahanti	SKS-00101	1911

7590

05/31/2006

Patent Group
Hutchins, Wheeler & Dittmar
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EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/840,446		MAHANTI ET AL.	
	Examiner		Art Unit	
	Olabode Akintola		3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-9, 11, 14, 18-19, 21, 22-23, 26-30, 32 and 39-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferstenberg et al. (U.S. Patent No. 5,873,071) (hereinafter referred to as Ferstenberg).

Re Claims 1 and 22: Ferstenberg teaches method and computer program product executed in a computer system for performing an electronic transaction comprising: connecting, by a plurality

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of users, to an electronic trading system, each user being associated with a unique negotiation agent (col. 3, lines 22-25); entering, by each of said plurality of users, at least one negotiation parameter (col. 3, lines 28-30); selecting, by each of said plurality of users, at least one item in connection with the electronic transaction (col. 3, lines 62-67); and automatically negotiating by the plurality of negotiation agents on behalf of said plurality of users for said at least one item, each of said plurality of agents automatically determining subsequent values for at least one negotiation parameter (col. 3, lines 42-44).

Re claims 2 and 23: Ferstenberg teaches the step comprising: automatically determining an initial offer in accordance with said at least one negotiation parameter and said at least one item (col. 13, lines 34-39); and receiving at least one counteroffer (col. 13, lines 39-43); determining that at least a portion of a received counteroffer is acceptable (col. 13, lines 40-49).

Re claims 5 and 26: Ferstenberg teaches the step comprising: updating said at least one negotiation parameter while negotiation process is ongoing (col. 41, lines 60-63).

Re claim 6 and 27: Ferstenberg teaches the step comprising: selecting by a user to terminate the negotiation after negotiation processing has been initiated (col. 13, lines 3-10).

Re claims 7 and 28: Ferstenberg teaches the step wherein said at least one negotiation parameter includes pricing information (col. 56, lines 19-24).

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Re claim 8 and 29: Ferstenberg teaches the step comprising: determining said initial offer using said at least one negotiation parameter that includes pricing information (col. 13, lines 34-39).

Re claim 9 and 30: Ferstenberg teaches the step comprising: determining at least one index in connection with at least one counteroffer (col. 5, lines 18-23).

Re claim 11 and 32: Ferstenberg teaches the step comprising: determining a response index representing a weighted average of all received counteroffers for one round (col. 5, lines 19-27); determining a target index representing a proximity to desired target values indicated in said at least one negotiation parameter (col. 20, lines 40-43); determining an offer index for each counteroffer representing for each counteroffer an indication of utility of the counteroffer (col. 3, lines 28-32); and determining a counteroffer index in accordance with said response index, said target index, and said offer index (col. 4, lines 19-29).

Re claim 14 and 35: Ferstenberg teaches the step comprising: determining a counteroffer using the counteroffer index using reverse interpolation between a minimum and maximum price range specified in said at least one negotiation parameter (col. 12, line 62 – col. 13, line 3).

Re claim 18 and 39: Ferstenberg teaches the step comprising: determining an offer using dynamic market information regarding said selected item, said dynamic market information reflecting current market conditions of said selected item in connection with trading of said selected item (col. 17, lines 13-17).

Re claim 19 and 40: Ferstenberg teaches the step comprising: determining an initial offer (col. 13, lines 34-39); receiving a plurality of counteroffers (col. 13, lines 39-43); determining at least one index associated with each counteroffer (col. 5, lines 18-23); and evaluating said plurality of counteroffers using said indices associated with each counteroffer (col. 19, lines 3-7).

Re claim 21 and 42: Ferstenberg teaches the step comprising: determining an initial offer (col. 13, lines 34-39); receiving a plurality of counteroffers (col. 13, lines 39-43); and determining a customized counteroffer for each of said received counteroffers (col. 17, lines 52-63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 12-13, 15-17, 20, 33-34, 36-38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferstenberg et al. (U.S. Patent No. 5,873,071) (hereinafter referred to as Ferstenberg)

Re Claim 12-13, 15-17, 20, 33-34, 36-38 and 41: Ferstenberg does not explicitly teach the steps

- Wherein each of said response index, said target index, said offer index and said counteroffer index each represent a curve comprising a plurality of points if said at least one negotiation parameter indicates that said electronic transaction is a partial fill order.
- Wherein each of said response index, said target index, said offer index and said counteroffer index each represent a single point for a particular quantity if said at least one negotiation parameter indicates that said electronic transaction is an all or none order.
- Wherein said counteroffer includes multiple points if said electronic transaction is a partial fill order, and wherein said counteroffer includes only a single point if said electronic transaction is an all or none type of order.
- Determining a negotiation region, an acceptable region and a rejection region in accordance with said at least one negotiation parameter; and using said negotiation, acceptable, and rejection regions in determining whether to accept any portion of a received counteroffer.

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- Representing said negotiation region, said acceptable region and said rejection region graphically as a two-dimensional figure if said electronic transaction is a partial fill order.
- Wherein each index represents a curve of a plurality of points, each point being represented as a price and quantity.

Official notice is hereby taken that it is old and well known in the art to generally represent parameters or variables in graphical formats (curve, multiple points, 2 or 3-Dimensional representations) to depict different scenarios under consideration. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferstenberg to include the aforementioned steps to create graphical depictions of various scenarios thereby enhancing the system.

Claims 3, 4, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferstenberg et al. (U.S. Patent No. 5,873,071) (hereinafter referred to as Ferstenberg) in view of Isaf et al. (U.S. Patent Application No. 2002/0007340) (hereinafter referred to as Isaf).

Re claim 3, 4, 24 and 25: Ferstenberg does not explicitly teach the step comprising: requiring user approval of an acceptable counteroffer. Isaf teaches the step comprising: requiring user approval of an acceptable counteroffer (section [0111]); wherein said user approval is obtained by soliciting an electronic response (section [0111]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferstenberg to include the

step comprising: requiring user approval of an acceptable counteroffer; wherein said user approval is obtained by soliciting an electronic response as taught by Isaf so that the agent would not need to further negotiate on the item.

Claims 10 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferstenberg et al. (U.S. Patent No. 5,873,071) (hereinafter referred to as Ferstenberg) in view of Kinney, Jr. et al. (U.S. Patent No. 6,871,191) (hereinafter referred to as Kinney).

Re claims 10 and 31: Ferstenberg does not explicitly teach the step comprising: determining whether a received counteroffer is at least partially acceptable if one of said negotiation parameters indicates that this electronic transaction may be partially filled with multiple orders; and determining whether a received counteroffer is one of completely rejected and completely accepted if one of said negotiation parameters indicates that this electronic transaction may be completely filled with a single order.

Kinney teaches the step comprising: determining whether a received counteroffer is at least partially acceptable if one of said negotiation parameters indicates that this electronic transaction may be partially filled with multiple orders; and determining whether a received counteroffer is one of completely rejected and completely accepted if one of said negotiation parameters indicates that this electronic transaction may be completely filled with a single order (col. 9, lines 21-28 and col. 10, lines 57-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferstenberg to include the step comprising: determining whether a received counteroffer is at least partially acceptable if one of said

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negotiation parameters indicates that this electronic transaction may be partially filled with multiple orders; and determining whether a received counteroffer is one of completely rejected and completely accepted if one of said negotiation parameters indicates that this electronic transaction may be completely filled with a single order as taught by Kinney to create an optimum allocation of orders thereby enhancing the efficiency of the system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OA



HANI M. KAZIMI
PRIMARY EXAMINER